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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,404	09/08/2005	Richard Ian Kitney	4586-4004	4625
27123 7590 08/20/2007 MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			EXAMINER RAMDHANIE, BOBBY	
			ART UNIT 1709	PAPER NUMBER
			MAIL DATE 08/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/512,404

Applicant(s)

KITNEY ET AL.

Examiner

Bobby Ramdhanie, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 9-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/22/2004, 01/24/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, are drawn to a container.

Group II, claim(s) 9-13, are drawn to a scanner with use of the container of Group I.

Group III, claim(s) 14-21, are drawn to a method of analyzing material with the use of the container of Group I.

Group IV, claim(s) 22-29, are drawn to a method of analyzing body tissue with use of the container of Group I.

Group V, claim(s) 30-40, are drawn to a method of analyzing body tissue at a locality with the use of the container of Group I.

2. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I-V share the common technical feature of the container of Group I. The container of Group I, does not provide a contribution over the prior art of record. There is no technical relationship among the inventions involving a corresponding special technical feature.

3. During a telephone conversation with James Hwa on 07/26/07 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 9-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 7, & 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Roemer et al (US4885539). Roemer et al teaches a container (Claim 1) for containing material to be analyzed using magnetic resonance (Claim 1), the container including a receive coil for use in analyzing material contained in the container and a connector for detachable connecting the receive coil, directly or via an adaptor, to an input of a magnetic resonance scanner (Figure 4, Item numbers 44a and 44b & Column 6 lines 22-27).

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7. For Claim 2, Roemer et al teaches a container according to Claim 1, wherein the connector provides an inductive coupling to the receive coil (Claim 1). Examiner takes the position that inductive coupling is the change in current flow through one device that induces current flow in the other device. The two devices may be physically contained in a single unit, or may be separated as in the antennae on the transmitter and the receiver or receive coil.

8. For Claim 3, Roemer et al teaches a container according to Claim 1, wherein the connector provides a direct electrical contact to the receive coil (Column 6 lines 9-27)

9. For Claim 5, Roemer et al teaches a container according to Claim 1, wherein the receive coil is also adapted for use as a transmit coil for use in analyzing material contained in the container (Claim 1 & Column 2 lines 32-39).

10. For Claim 7, Roemer et al teaches a container according to Claim 1, wherein the receive coil is constructed as a volume coil such that material to be analyzed can be placed inside the coil (Claims 1 & 2; Column 2 lines 32-39).

11. For Claim 8, Roemer et al teaches a container according to Claim 1, wherein the container is made of non-ferromagnetic material such that material contained in the container can be analyzed by use of an excitation pulse generated by use of at least one transmit coil external to the container (Claim 1 & 2, Column 2 lines 32-39).

12. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballon et al. Regarding Claim 1, Ballon et al teaches a container for containing material to be analyzed using magnetic resonance, the container including a receive coil for use in analyzing material contained in the container and a connector for detachably

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connecting the receive coil, directly or via an adaptor, to an input of a magnetic resonance scanner (Figure 2 and Page 755 2nd Column 1st Paragraph).

13. For Claim 6, Ballon et al teaches a container according to Claim 1 wherein the container is sealable (Figure 2a).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roemer et al in view of Durrasse et al (EP0468857). Regarding Claim 2, Roemer et al teaches a container according to Claim 1. Roemer et al does not explicitly teach that the connector provides an inductive coupling to the receive coil. Durrasse et al teaches this feature. Durrasse et al teaches that the connector provides an inductive coupling to the receive coil (Page 1 of translation. 1st Paragraph). It would have been obvious to one of ordinary

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skill in the art at the time the invention was made, to modify Roemer et al with Durrasse et al because according to Durrasse et al, this has the advantage of allowing one to examine a local area on the body or a specific zone inside the body of an animal, both of which could not be done with traditional cable connections (Page 2 of translation Top Paragraph).

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roemer et al in view of Leussler (US5245288). Roemer et al teaches all of the claim limitations of Claim 1. Roemer et al does not teach the connector includes a transmitter for establishing a wireless link between the receive coil and the input of the magnetic resonance scanner. Leussler teaches this feature. Leussler teaches the connector includes a transmitter for establishing a wireless link between the receive coil and the input of the magnetic resonance scanner (Abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Roemer et al with Leussler because according to Leussler, disturbing effects are liable to occur when a coil system is connected to the processing unit via a cable and can be avoided by using a transmitter via a wireless link between the receive coil and the input of the magnetic resonance scanner (Abstract).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bobby Ramdhanie, Ph.D. whose telephone number is 571-272-1447. The examiner can normally be reached on Mon-Fri 8-5 (Alt Fri off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Walter Griffin can be reached on 571-270-3240. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BR

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